

REMARKS

Claims 1-40 were originally filed. By way of this amendment, Applicant has added new dependent claim 41. Claims 1-41 are therefore pending.

Restriction Requirement

The Examiner has identified nine species of exendin agonist requiring restriction, including:

“...exendin-4 acid, exendin-4 (1-30), exendin-4 (1-30) amide, exendin-4 (1-28) amide, ¹⁴Lue, ²⁵Phe exendin-4, and ¹⁴Leu, ²⁵Phe exendin-4 (1-28) amide; and there are three formulas of exendin agonist in claims 16-18, 21-23 and 38-40, and they are formulas I-III. Each of the nine agonists has a distinct structure from the others, and each requires a separate search of the prior art.”

Applicant hereby elects with traverse the claims drawn to the species exendin-4. Although distinct, the species recited in the application share a common utility of modulating triglyceride levels. The Examiner has identified only nine species of exendin agonist. Applicant submits that this constitutes a reasonable number of species and that a search and examination of the entire application can be made without a serious burden on the Patent Office (see MPEP §803). Applicant respectfully requests that the election requirement be withdrawn.

Currently, claims 1-10, 12, 15, 19, 24-32, 34, 37, and new claim 41 are generic to the Applicant's elected species exendin-4.

Applicant reserves the right to consideration of a reasonable number of disclosed species in addition to the elected species as provided by 37 CFR § 1.141 should claim 1 or another generic claim eventually be allowed.

With respect to new claim 41, Applicant respectfully request Examination of all species encompassed by the Markush group. Applicant directs the Examiner to M.P.E.P. section 803.02, providing in part the following:

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure described below and will not require restriction.

Since the decisions in *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1978) and *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978), it is improper for the Office to refuse to examine that which applicants regard as their invention, unless the subject matter in a claim lacks unity of invention. *In re Harnish*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980); and *Ex parte Hozumi*, 3 USPQ2d 1059 (Bd. Pat. App. & Int. 1984). Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility. (emphasis added)

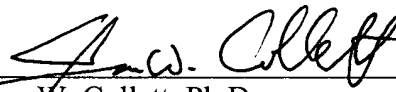
There are only six or eight compounds encompassed by the Markush groups, and they are all related. Further, all compounds clearly share a common utility of being exendin agonists. Applicant respectfully submits that the compounds are sufficiently few in number such that a search and examination of the entire claim set can be made without serious burden.

The Examiner is invited to call Applicant's undersigned attorney if prosecution will be furthered thereby.

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Respectfully submitted,

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